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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/622,286	07/18/2003	Ernie F. Brickell	42P14058	4599
8791	7590	11/07/2006	EXAMINER	
BLAKELY SOKOLOFF TAYLOR & ZAFMAN 12400 WILSHIRE BOULEVARD SEVENTH FLOOR LOS ANGELES, CA 90025-1030			OLATUNJI, OLATUNDE O	
			ART UNIT	PAPER NUMBER
			2135	

DATE MAILED: 11/07/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

10/622,286

Applicant(s)

BRICKELL, ERNIE F.

Examiner

Olatunde Olatunji

Art Unit

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 10/17/2003.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-25 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-25 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 07/18/2003 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. _____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|---|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) |
| 2) <input type="checkbox"/> Notice of Draftperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____ |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

Claim(s) 1-25 have been presented for examination.

Claim Rejections - 35 USC § 101

35 U.S.C. 101 reads as follows:

Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.

Claims 12-25 are rejected under 35 U.S.C. 101 because the claimed invention is directed to non-statutory subject matter. Claims 12-25 are directed to a machine-readable medium. In this instance, this subject matter is not limited to that which falls within a statutory category of invention because it is not limited to a process, machine, manufacture, or a composition of matter. Instead, Applicant's specification provides intrinsic evidence on page 7 ¶ [15] and page 11 ¶ [26], it includes the operations and methods may be implemented as a set of instructions embedded in a carrier wave.

A set of instructions embedded in a carrier wave are not limited to media which falls within a statutory category since they are clearly not a series of steps or acts to constitute a process, not limited to a mechanical device or combination of mechanical devices to constitute a machine, nor a tangible physical article or object which is some form of matter to be a product and constitute a manufacture, nor a composition of two or more substances to constitute a composition of matter.

Claim Rejections - 35 USC § 112

The following is a quotation of the second paragraph of 35 U.S.C. 112:

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The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

Claim 5 recites the limitation "accepting the request to revoke the second party's certificate". There is insufficient antecedent basis for this limitation in the claim.

Claim Rejections - 35 USC § 102

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

Claims 1-6 and 11-21 are rejected under 35 U.S.C. 102(e) as being anticipated by Cook et al., U.S. Patent No. 6,922,776.

With the respect to claims 1 and 16, Cook reference teaches registering a first party as a party relying upon a second party's certificate (see col. 6, lines 38-44; *a creator uploading a certificate for a user is equivalent to registering a user based on a creator certificate*);

revoking the second party's certificate after registering the first party (see col. 6, lines 47-54; col. 7, lines 13-20; *replacement of the entire electronic certificate with a new electronic certificate*); and

initiating communication with the first party to indicate that the second party's certificate has been revoked (see col. 6, lines 55-62; *certificate server second module is for notifying a user of the electronic certificate condition when its revoked*).

With the respect to claims 2 and 17, Cook reference teaches wherein revoking the second party's certification further comprises: receiving a request to revoke the second party's certificate (see col. 7, lines 13-22; col. 7, lines 40-48; *revocation of the electronic certificate*); and

revoking the second party's certificate in accordance with a revocation policy associated with the second party's certificate in response to the request (see col. 7, lines 13-22; col. 7, lines 40-48; *revocation of the electronic certificate*).

With the respect to claims 3 and 18, Cook reference teaches wherein initiating communication with the first party (see col. 6, lines 55-57; *certificate server second module is for notifying a user*) further comprises sending a revocation message to a machine (see col. 6, lines 44-47 "workstation, pc, fax machine, etc") that is associated with the first party (see col. 7, lines 1-8; col. 7, lines 40-48; *notify by electronic mail the certificate user the certificate change of condition like revocation*).

With the respect to claims 4 and 19, Cook reference teaches further comprising the machine (see col. 6, lines 44-47; "workstation, pc, fax machine, etc...") associated with the first party verifying the authenticity of the revocation message (see col. 7, lines

1-8; col. 7, lines 40-48; col. 8 line 60-col. 9 line 5; "*executing various authentication procedure*") and modifying access control information of the machine to indicate the revocation of the second party's certificate (see col. 8, lines 1-5; "*updating the electronic certificate with respect to the certificate user to the new version of the electronic certificate*").

With the respect to claims 5 and 20, reference teaches wherein accepting the request to revoke the second party's certificate comprises accepting the request by authenticating a signature (see col. 8, lines 60-64; "*The certificate server may sign, or authenticate Alice's electronic certificate*") incorporated in the request with one of a list of revoker certificates associated with the second party's certificate (see col. 7, lines 30-34; *a certificate revocation list-CRL*).

With the respect to claims 6 and 21, Cook reference teaches wherein the server initiating communication with a first party (see col. 6, lines 55-57; *certificate server second module is for notifying a user*) further comprises the server sending an email message to an email address for the first party (see col. 7, lines 1-8; "*electronic mail*").

With the respect to claim 11, Cook reference teaches a processor based server system (see col. 6, lines 35-38) comprising: a registration database (see col. 10, lines 10-30; *selection of contracts associated with users are stored in a database on the certificate server*) to register a first party as a relying party for a second party's

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certificate (see col. 6, lines 38-44; *a creator uploading a certificate for a user is equivalent to registering a user based on a creator certificate*);

a revocation module (see col. 6, lines 38-41; col. 7, lines 40-48) to revoke the second party's certificate after the first party is registered (see col. 6, lines 47-54; *revocation/replacement of the entire electronic certificate with a new electronic certificate*); and

an interface with a communication network (see col. 5, lines 19-28; *a communication channel that comprise a network*) to initiate communication to indicate to the first party that the second party's certificate has been revoked (see col. 6, lines 55-62; *certificate server second module is for notifying a user of the electronic certificate condition when its revoked*).

With the respect to claim 12, Cook reference teaches further comprising: a machine readable medium accessible from a processor of the server (see col. 8, lines 47-50; *electronic certificate may be distributed on machine readable magnetic/optical media*) having stored thereon an acceptance policy in accordance with which a revocation request received via the interface may be accepted (see col. 8, lines 47-50; *"electronic certificate"*), and further having stored thereon a revocation policy in accordance with which the second party's certificate may be revoked (see col. 8, lines 16-20; col. 6, lines 61-62; col. 7, lines 40-44; *the certificate server stores electronic certificates with conditions of revocation*).

With the respect to claim 13, Cook reference teaches wherein the revocation module is operable to send a revocation message to a machine that is associated with the first party, via the interface (see col. 6, lines 55-62; col. 7, lines 1-8; col. 7, lines 40-48; col. 8, lines 51-59; *certificate server second module is for notifying a user of the electronic certificate condition of revocation through electronic mail to the users workstation, pc, or other type of processors capable of electronic communications*).

With the respect to claim 15, Cook reference teaches wherein the revocation module (see col. 6, lines 38-41; col. 7, lines 40-48) is operable to send a revocation message to a machine operable by the user (see col. 7, lines 1-8; col. 7, lines 40-48) to access the web site (see col. 10, lines 5-9).

With the respect to claim 14, Cook reference teaches a processor based server (see col. 6, lines 35-38) comprising: a registration database (see col. 10, lines 10-30; *selection of contracts associated with users are stored in a database on the certificate server*) to register a user as a relying party for a digital certificate of a web site, the certificate to verify messages from the web site (see col. 6, lines 38-44; *a creator uploading a certificate for a user is equivalent to registering a user based on a creator certificate*);

a machine readable medium accessible from a processor of the server (see col. 8, lines 47-50; *electronic certificate may be distributed on machine readable magnetic/optical media*) having stored thereon an acceptance policy in accordance with

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which a revocation request received via an interface to communication network may be accepted (see col. 8, lines 47-50; *"electronic certificate"*), and further having stored thereon a revocation policy in accordance with which the digital certificate of the web site may be revoked in response to the revocation request (see col. 8, lines 16-20; col. 6, lines 55-62; col. 7, lines 40-48; *the certificate server stores electronic certificates with conditions of revocation*);

a revocation module (see col. 6, lines 38-41; col. 7, lines 40-48) to revoke the digital certificate of the web site in accordance with the revocation policy (see col. 6, lines 47-54; col. 7, lines 40-45; *revocation/replacement of the entire electronic certificate with a new electronic certificate*); and

an interface with a communication network (see col. 5, lines 19-28; *a communication channel that comprise a network*) to indicate to the user that the web site's certificate has been revoked (see col. 6, lines 55-62; *certificate server second module is for notifying a user of the electronic certificate condition when revoked*).

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 7-10 and 22-25 are rejected under 35 U.S.C. 103(a) as being unpatentable over Cook et al. U.S. Patent #6,922,776 in view of Kaliski Jr., U.S. Patent #6,085,320.

With the respect to claims 7 and 22, Cook reference teaches registering an user as a party relying upon a digital certificate for a web site, the certificate to verify messages from the web site (see col. 6, lines 38-44);

receiving a request to revoke the digital certificate of the web site after registering the user (see; col. 7, lines 13-22; col. 7, lines 40-48);

revoking the digital certificate of the web site in response to the request (see col. 6, lines 47-54; col. 7, lines 13-22; col. 7, lines 40-48); and

initiating communication with the user to indicate that the digital certificate of the web site has been revoked (see col. 6, lines 55-62).

Cook reference doesn't teach authenticating the request in accordance with a pre-defined policy. Kaliski Jr. reference teaches authenticating the request in accordance with a pre-defined policy (see col. 2, lines 22-35; col. 4, lines 5-9; col. 5, lines 30-31). It would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains to have modified Cook reference to include the teachings of Kaliski Jr. to have included the step of authenticating the request in accordance with a pre-defined policy for the integrity of the communication between the parties and also "for protection against the certification authority or unauthorized servers, respectively" (see Kaliski Jr. col. 2, lines 39-41).

With the respect to claims 8 and 23, Cook reference teaches wherein initiating communication with the user to indicate that the digital certificate of the web site has been revoked (see col. 6, lines 55-62) further comprises:

 sending a message directly to a machine (see col. 6, lines 44-47; "*workstation, pc, fax machine, etc*") associated with the user, to indicate that the web site's digital certificate has been revoked (see col. 6, lines 55-62; col. 7, lines 1-8; col. 7, lines 40-48).

With the respect to claims 9 and 24, Cook reference teaches further comprising, in the machine used by the user (see col. 6, lines 44-47; "*workstation, pc, fax machine, etc*"): authenticating the message to verify that it was sent by the server (see col. 7, lines 1-8; col. 7, lines 40-48; col. 8 line 60-col. 9 line 5); and

 changing settings for web access to reflect the revocation of the digital certificate of the web site (see col. 7, lines 13-20; col. 9 lines 3-5).

With the respect to claims 10 and 25, Cook reference teaches authenticating a digital signature (see col. 8, lines 60-64) incorporated in the request with a list of digital certificates previously defined as revoker certificates for the web site (see col. 7, lines 30-34).

Prior Art Made of Record

The prior art made of record and not relied upon is considered pertinent to applicant's disclosure. The following patents and patent applications are cited to further show the state of the art with respect to revocation distribution, such as:

United States P.G. Pub. No. 2002/0056050 to Heiden et al., is cited to show method and system for revocation of certificates used to certify public key users.

United States P.G. Pub. No. 2003/0037234 to Fu et al., is cited to show Method and apparatus for centralizing a certificate revocation list in a certificate authority cluster.

United States P.G. Pub. No. 2005/0021969 to Williams et al., is cited to show delegating certificate validation.

United States P.G. Pub. No. 2002/0184182 to Kwan, is cited to show a method and system for answering online certificate status protocol (OCSP) requests without certificate revocation lists (CRL).

Conclusion

All claims are rejected.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Olatunde Olatunji whose telephone number is (571) 270-1020. The examiner can normally be reached on M-TR 7:30-5pm EST & 2nd Friday 7:30-4pm EST.

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If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Kim Vu can be reached on (571) 272-3859. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.


Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

O.O.

Olatunde Olatunji

10/29/06

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